

CERTIFICATE

This petition is in my judgment well founded, and is not interposed for purpose of delay.

MARSTON ALLEN,
Attorney for Petitioners.

BRIEF IN SUPPORT OF PETITION FOR CERTIORARI

OPINIONS OF THE COURTS BELOW

The District Court opinion appears in 53 Fed. Supp. 288.

The opinion of the Court of Appeals appears in 150 Fed. (2d) 656, and at the conclusion of the transcript furnished herewith.

JURISDICTION

The statute under which jurisdiction is invoked is 240 (2) of the Judicial Code, 28 U. S. C. A. 347, as amended by the Act of February 13, 1925.

SPECIFICATION OF ERRORS

If the petition for certiorari is granted, the errors that petitioners will urge as residing in the judgment of the Circuit Court of Appeals are as follows:

1. In failing to consider the historical impact of the invention on the existing art in appraising inventive novelty as against mechanical skill, when holding contrary to the decision of the appellate tribunal of the United States Patent Office on this point.

2. In holding that the express statements in the patents of the prior art with regard to the basic purposes of the described inventions, should be disregarded because they were incorrect or incomplete, when appraising what was

known by the art and what was not; and in accepting as conclusive of what was and what was not known, the fact that the devices of the prior art could be stripped of parts and still operate.

3. In relying on the testimony of experts as to what the art would know, and giving no regard to what the art had in fact done as the result of the patented invention.

4. In failing to hold that the patent in suit was valid on the authority of *Lawther v. Hamilton*, 124 U. S. 1 and *Dunn Mfg. Co. v. Standard Computing Scale Co.*, 163 F. 521.

STATEMENT

(The drawings from the prior art referred to below are reproduced at the appendix at the back of this brief.)

The LaCour patent, Fig. 3 (Appen.), shows the original toothed disk single magnet pole motor. Fig. 3 of Hammond patent (Appen.) shows a two pole toothed disk motor which was in use when the patent in suit was brought to the attention of the defendant, Hammond Clock Co. This was as far as the art could go.

Efforts to supply a toothed disk motor with a *series of magnet teeth* instead of one or two, thus to develop power and stability, resulted initially in Coerper patent, Fig. 1 (Appen.), which employed two complete magnets arranged with adjacent poles of opposite polarity, presenting a series of poles to the toothed disk. The Coerper patent said that if "the changes of polarity in the magnetic field follow each other in such quick succession," then the magnetism induced in the armature remains active. If this be true, and it is the basis for the Coerper structure, it was necessary for each tooth on the rotary disk to keep the same induced magnetism at all times, and adjacent magnet teeth would have to be of different polarity one from the other, a condition not found in the patented motor. To attain its

simplicity, adjacent pole teeth must have the same polarity. This would not work if the teeth on the rotary disk held their magnetism.

Another effort to supply a series of magnet poles with a toothed disk rotor is Thomson patent (see Fig. 4, Appen.). This motor has two opposite poles (marked S and N), formed into teeth, but the teeth are spaced twice the spacing of the teeth on the rotating disk, and the teeth on the rotating disk each have a winding about them, and this winding is supplied with current by means of conductors A and B, and brushes on the axle of the disk, thus controlling the polarity of the teeth of the disk. The patent in suit has no tooth windings and no brushes, etc.

The Holtz patent, Fig. 2 (Appen.), shows a rotor with wide teeth having windings between them called a squirrel cage. It has two poles for the magnet, one-half of each pole being surrounded with a ring or winding marked 11, and 12. This patent states that the rings 11 and 12 "change the pulsating flux of the field into a so-called shifting or substantially rotating magnetic field, in the cylindrical space between the opposite poles of the field magnet." The patent in suit has a *reciprocating* field.

If one takes the Coerper motor, removes one of the magnets completely, widens the poles on the other magnet and cuts teeth in them corresponding to the teeth of the rotating disk, he would have a motor operating like the O'Leary motor. But the patent teaches this would not work. If in the Thomson motor the windings were removed from the teeth of the rotating disk, and the brushes and connections for sending current through these windings were removed, and the teeth on the magnet doubled in number, an O'Leary motor would be produced. If the rings or windings 11 and 12 were removed from the Holtz motor and *the spaces occupied by these windings still left in the poles*, and the squirrel cage winding removed from

the rotating disk, then a motor would be produced which operates like the O'Leary motor of the patent in suit. Yet the O'Leary motor operates on a different theory from any of these (Decision of the Court of Appeals).

The O'Leary patent structure, Fig. 1 (Appen.), may be described by claim 7 in the patent:

"7. A bi-polar synchronous motor of the core type having an armature provided with a plurality of unwound radial pole arms terminating in pole faces, a field core having a pair of poles each provided with a plurality of inwardly extending projections terminating in pole faces, the centers of the pole faces on the armature having the same angular spacing about the axis of rotation as the angular spacing of the centers of the pole faces of the field magnet about the same axis, and a winding linking the core for producing an alternating magnetic flux throughout the structure, whereby the lines of magnetic force acting on the armature lie in substantially the plane of rotation of the armature when said winding is energized from an alternating source of current."

It will be noted that this leaves off all the various features of the previous motors using only a horse shoe shaped piece of iron with a coil around its leg and a series of teeth on its prongs. Within the prongs is a toothed disk with like teeth, no windings on the teeth of either the magnet or the disk. In such a motor the flow of magnetism is directly across the disk instead of moving through its periphery from one magnet fold to the next. (Opinion C. C. A., p. 4.) No previous motor had such an arrangement, but always there were modifications by one means or another to avoid or mitigate such a condition. Did the art know that a two pole multi-toothed magnet would operate without tooth windings of any kind? That is the primary question, not answered by demonstrating the operation to be effective.

In the Patent Office with the other patents referred to by the Court of Appeals in its opinion, except Holtz before them, the Board of Appeals said:

“While the structure and principle of operation of applicant’s machine after being disclosed appears obviously quite simple, it is our opinion that the extreme simplicity indicates invention over the relatively complex structures disclosed by the references. We believe invention is involved in this radical simplification of the device in view of the differences in structure involved in accomplishing it. Neither the structure nor the exact principle of operation of applicant’s device is anticipated by any of the citations and it is our opinion that invention is invoiced therein.”

There is no question from the opinion of the Court of Appeals but that the “exact principle of operation” of the O’Leary device was new, over any previous motor. It obviously involved a major departure from prior practices toward simplicity in efficient motors having a series of magnet teeth rather than just one or two.

The record shows that the true defendants, Westclox, Ingraham and Hammond, each had the O’Leary motor brought to their attention, each negotiated with the plaintiffs, each changed to the O’Leary style of motor (R. 192, 188, 179). No substantial offer was made to O’Leary, and indeed, Westclox made a nominal offer for license and stated to O’Leary that “they would beat me” if I tried to take it into court, and “I could not afford to fight them,” and that “they were a big outfit” (see Rec. p. 191).

The Depression was on. Just preceding the Depression O’Leary obtained a licensee for phonograph motors on a substantial annual royalty (R. 176). This licensee failed.

The Depression ended the efforts of O’Leary Sr. to get his invention adopted. He ran out of money (R. 185), at

a time when he was almost tooled up for production of clocks. He became ill and died. His son, Allan O'Leary, who was with him, at last got a job driving a trolley bus at Dayton, Ohio, the home of the O'Learys, at \$25.00 a week. Allan lived at home and was the sole support of his mother. The other son, William O'Leary, at the beginning of the Depression was a teacher, left his assistantship at Cornell University and got a position as a chemist petrographer at \$200.00 a month. He was married, and was in no position to finance any patent suit. By the time that Allan O'Leary got financial assistance from friends in Dayton to bring the present suits (R. 187) he had become an instructor in engineering, drawing and mathematics at Dayton University, and had fully notified the art of his father's patent, calling their attention to infringement, and he it was who had carried on the negotiations, among others, with Westelox, Ingraham and Hammond. He had conferred with counsel for the Gilbert Clock Co., the fourth of the defending Companies in this litigation, but found that the attorneys represented a coalition of New England clock manufacturers, including Waterbury and Union, who were prepared to fight him as to the patent (R. 191). By this time also all non-self-starting electric clocks and non-self-starting phonograph motors were of the type responding to the O'Leary patent, of which we have quoted claim 7.

ARGUMENT

On the above facts and the facts stated in the petition, it is maintained that a determination of whether or not the persons skilled in the art would know that a multi-toothed magnet such as O'Leary used, would really work to make an efficient motor without any tooth windings whatever either on the magnet or rotary portion of the

motor, cannot be made without taking into consideration what those skilled in the art did before O'Leary came along and what they did after his invention was called to their attention. The effect of the impact of the invention on the art under the circumstances of this case is not a matter of "commercial success." The O'Learys certainly made no money.

We consider that where an invention consists of development toward simplicity and cheapness, it must have been an objective of the industry involved, and the fact that all the industry shifted to the O'Leary motor, or started anew to build up a business on the basis of the O'Leary motor, is pertinent and indeed almost determinative of the question here of whether the simplification was or was not mere mechanical skill.

It was easy for the experts Spencer and Fox, for the combined defendants below, to say, after the event, that there was nothing to the O'Leary motor but the omission of features of previous motors together with omission of the valuable adjuncts which they contributed to the operation thereof. But if the truth was that, faced with competition with each other, those in the business of making small simple motors neither made nor advocated anything so simple as O'Leary made, and at once that O'Leary came to their attention, shifted to his simple construction, these opinions of experts employed by the defendants, should be given almost no credence whatever.

We must add one other fact, viz., that these experts based their opinion and were able to convince the Courts below, by demonstrations which violated the teachings of the patents on the very motors used in the demonstrations.

We realize as stated in the opinion of the Court of Appeals (page 18) that this Court has taken the position that it will not disturb concurrent findings of the District Court and the Circuit Court of Appeals where there is

evidence to support them. In this case frankly both lower Courts found that only mechanical skill was involved in the novelty of the O'Leary motor. As stated in the petition herewith our position is that this conclusion was made without considering essential facts and that on the real facts as distinguished from conclusions drawn therefrom there is no sound and logical basis for a holding of mere mechanical skill.

Both Courts in this case adopted as the controlling authority the case of *The Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84, and were reluctant to find a shift in emphasis in the later decision of this Court in *Goodyear Tire & Rubber Co., Inc. v. Ray-O-Vac Co.*, 321 U. S. 275. We believe that this Court in the *Sinclair & Co. v. Interchemical Corp.* decision, published May 21, 1945, has taken another step in approaching that appraisal of invention which is intuitive in the American mind when it said:

"This test is often difficult to apply, but its purpose is clear. Under this test, some substantial innovation is necessary, an innovation for which society is truly indebted to the efforts of the patentee. Whether or not those efforts are of a special kind does not concern us."

It is true that this Court in *Dow Chemical Co. v. Halliburton Oil Well Cementing Co.*, decided March 5, 1945, ... U. S. ..., refused to consider the contention that the Grebe-Sanford process had filled a long-felt want, but as the discussion of the Court at the conclusion of the opinion shows, the inventors had there simply "drawn upon a great fund of public knowledge . . . the first time the problem was considered." Such a situation is extremely remote from the present one.

If this case is taken by the Supreme Court, we have every confidence that the O'Learys will be able to obtain funds to proceed, and that we will be able to convince the Court that both the District Court and the Circuit Court of Appeals were quite unjustified by the record in the conclusion that no more than mechanical skill was involved in the invention of the patent in suit.

Respectfully submitted,

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